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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,163	06/02/2006	Danny A. Grant	IMM152B (I103 1940US)	3281
69490	7590	10/27/2010	EXAMINER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/538,163	GRANT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hyun Nam	2184	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 August 2010.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 2,11,14-25 and 27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-10,12,13,26 and 28-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/11/2010, 9/20/2010</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Obvious-type Double Patenting Rejections***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2184

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3-5, 10, 12, 13, 26, and 28-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8-11, 17-23, and 29-31 of copending Application No. 10/538,162, hereinafter Grant '162. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims	Instant	Claims	Grant '162
1, 10, 26, 33, or 34	Generating an output signal to Second from First Signal includes Haptic Code Code Id's First Actuation of member(s) Haptic Effect on Second Code Id's Status Event Hand held Com. Device	4, 11, 18,	Receiving an input signal from Sending Party Signal includes Haptic Code Code/Logo Id's Sender Control Signal on Actuator Haptic Effect on Receiver Logo ID's Status Event Hand held Com. Device

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-5, 10, 12, 13, 26, and 28-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaaresoja et al. (U.S. Publication Number 2002/0177471) hereinafter Kaaresoja '471 'evidenced' or 'in view of' Ronkainen (U.S. Patent 6,850,150) here in after Ronkainen '150.**

Examiner recognizes that, a single rejection under either 35 U.S.C. 102 or 35 U.S.C. 103(a) should be made whenever possible; however, circumstances where 102/103 rejection is appropriate are as follows:

- a. *When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate. See MPEP §§ 2111-2116.01 for guidelines on claim interpretation.*
- b. *When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02.*

The Examiner has construed that the claimed limitation 'a haptic code configured to distinctly identify the first handheld communication device and a status event' as a 'caller id' via haptic effect on a phone: 'caller-id' feature identifies 'a caller' and indicates 'a call event' which is a status of the phone. Although, not all the phones inherently have a caller-id feature, the given evidence seems to indicate that a communication device disclosed in Kaaresoja '471 has a caller-id feature. Additionally, evidence seems to indicate that the caller-id feature is implemented with haptic effect. The paragraphs 7-10 in Kaaresoja '471 suggest improving upon the designs of Ronkainen '150. One of the features that are to be improved upon is the caller-id feature (see Kaaresoja '471, Paragraph 9 and see Ronkainen '150 Column 2, Lines 25-40)

Referring to claim 1, Kaaresoja '471 teaches, as claimed, a method, comprising:

generating, at a first handheld communication device (mobile phone, see Paragraph 17, Line 2), an output signal (see Fig. 1, Antenna 102) upon an actuation of one or more of a plurality of user-interface members (a key of keys on keypad, see Fig. 1, Keypad 108 and Paragraph 17, Line 6) of the first handheld communication device, wherein the output signal includes a haptic code (see Fig. 1, Control Signal to Vibration Motor 100) and

sending the output signal to a second handheld communication device (mobile phone, see Paragraph 17, Line 2) remote from the first handheld communication device (see Paragraph 24, Lines 9-11; Note, tactile icons composed from one device is sent to another remote device), wherein the output signal is configured to cause a haptic effect corresponding to the haptic code (haptic effect due to vibration of a motor, see Paragraphs 9 and 11).

Kaaresoja '471 does not disclose expressly a haptic code configured to distinctly identify the first handheld communication device and a status event (i.e. in case where inherency of this feature maybe in dispute).

Ronkainen '150 does disclose a haptic code configured to distinctly identify the first handheld communication device and a status event (see Column 2, Lines 25-40; Note, the Ronkainen '150 is recited in paragraphs 7-10 of Kaaresoja '471).

At the time of the invention, if not inherent, it would have been obvious to a person of ordinary skill in the art to incorporate Ronkainen '150 into Kaaresoja '471.

The suggestion/motivation for doing so would have been to engage the senses of touching without eliminating essential features of previous designs (see Kaaresoja '471, Paragraphs 10 and 11).

As to claim 3, Kaaresoja '471 teaches, the method of claim 1 wherein sending further includes in the output signal at least one of a message (voice message, see Fig. 1, Loudspeaker 114), a video image (an animation, see Paragraph 18, Line 4), and a graphical feature (pictures, see Paragraph 18, Line 3).

As to claim 4, Kaaresoja '471 teaches, the method of claim 1 wherein the haptic code is associated with a predetermined scheme (see Fig. 1, stored vibration pattern 140e; Note, predetermined vibrations patterns are stored in the memory for later determination of tactile sensation to be sent or received).

As to claim 5, Kaaresoja '471 teaches, the method of claim 1 wherein receiving further includes defining the one of the user-interface members (see Paragraph 17, Line 6; Note, a menu item is defined to the key in the keypad) include at least one of a key, a button, a key pad (see Fig. 1, Keypad 108), a direction pad, a touch screen, a scroll

wheel, a mini-joystick, a trackball, and a knob (Note, the Keypad 108 is one of the user-interface member listed above).

As to claims 10, 12, and 13, they are directed to a non-transient computer-readable medium on which is encoded program code to implement the methods as set forth in claims 1, 3, and 4 respectively. Therefore, they are rejected on the same basis as set forth hereinabove.

As to claim 26, it is directed to a handheld communication device to implement the method as set forth in claim 1. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claim 28, Kaaresoja '471 teaches, the handheld communication device of claim 26, wherein the handheld communication device is one of a cellular phone (see Fig. 1, a Block Diagram of a Mobile Phone), a satellite phone, a cordless phone, a personal digital assistant, a pager, a two-way radio, a portable computer, a game console controller, a personal gaming device, and an MP3 player (Note, the mobile phone is one of the device listed above).

As to claim 29, Kaaresoja '471 teaches, the handheld communication device of claim 26 wherein the plurality of user-interface members includes at least one of a key (a key on keypad, see Fig. 1, Keypad 108), a button, a key pad (see Fig. 1, Keypad 108), a

direction pad, a touch screen, a scroll wheel, a mini-joystick, a trackball, and a knob  
(Note, the Keypad 108 is one of the user-interface member listed above).

As to claims 30, Kaaresoja '471 teaches, the handheld communication device of claim 26 further comprising memory (see Fig. 1, Memory 140), wherein the memory stores program code (see Fig. 1, Vibration pattern interpreter 140a) for extracting a haptic stimuli (see Fig. 2, Vibration patterns) from the input signal.

As to claim 31, Kaaresoja '471 teaches, the handheld communication device of claim 26 further comprising a display device (see Fig. 1, Display 110) in communication with the processor (see Fig. 1, Controller 106), the processor to cause the display device to produce an image of the identified source (pictures, see Paragraph 18, Line 3).

**Claims 32-34 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471/Rokainen '150 further in view of Wanderlich (U.S. Patent 6,028,531), hereinafter Wanderlich '531.**

As to claims 32, Kaaresoja '471 teaches a method to implement the same method as set forth in claim 1.

Kaaresoja '471 does not expressly disclose a method comprising user-interface member being assigned to a haptic code.

Wanderlich '531 does disclose a switch being assigned to a tone and a vibration (see Fig. 2, Switch 40). Furthermore, Wanderlich '531 disclose numeral 0 thru 9 being assigned to combination of signal amplitude, vibration frequency, and duration (see Column 7, Lines -6-25).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to assign a haptic code or vibration pattern/signal to a switch/keypad on a mobile device of Kaaresoja '471.

The suggestion/motivation for doing so would have been to have convenient access and feel to the most frequently used or favorite vibration pattern.

As to claims 33, it is directed to a program code to implement the method as set forth in claim 32. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claims 34, it is directed to a device to implement the method as set forth in claim 32. Therefore, it is rejected on the same basis as set forth hereinabove.

**Claims 35-37 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471/Rokainen '150 further in view of Epstein et al. (U.S. Publication 2003/0038776), hereinafter Epstein '729 and Amon (U.S. Publication 2002/0107936), hereinafter Amon '936.**

Referring to claims 35-37, Kaaresoja '471 teaches, as claimed, a method of claim 1, a non-transient computer readable medium of claim 10, and a device of claim 26 respectively.

Kaaresoja '471 does not disclose expressly wherein the status event is selected from the group consisting of an advertisement event, a one-to-one marketing event, a business-transaction event, a stock-trading event, a weather-forecast event, and an emergency event.

Epstein '729 does disclose a wherein the status events consisting of an advertisement event (see Paragraph 14), a one-to-one marketing event (see Paragraph 16), a business-transaction event (see Paragraph 27), and a stock-trading event (exchange, see Title and Fig. 11).

Amon '936 does disclose a weather-forecast event (see Paragraph 16) and an emergency event (see Fig. 6).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate status events of Epstein '729 and Amon '936 into Kaaresoja '471.

The suggestion/motivation for doing so would have been to provide most comprehensive mobile PDA and/or Phone services.

**Claims 38-42 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471/Rokainen '150 further in view of Fukuhara et al, 'Voice Café: Conversation Support System' hereinafter Fukuhara.**

As to claims 38, Kaaresoja '471 teaches a method of claim 1, wherein the output signal is sent during a session (emails and non-verbal stylized message, see Paragraphs 4, 5, and 16) between the first handheld communication device and the second handheld communication device.

Kaaresoja '471 does not disclose expressly a chat session.

Fukuhara does disclose a chat session (Computer Mediated Communication tools, see Page 2) via haptic means.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate chat session into non-verbal sessions of Kaaresoja '471.

The suggestion/motivation for doing so would have been to broaden the means to share tactile information and engage the sense of touch over the network (see Fukuhara Pages 1-2 and see Kaaresoja '471, Paragraph 10).

As to claim 39, the modification teaches, the method of claim 38, wherein the haptic code (see Fig. 1, Control Signal to Vibration Motor; Note, the Instant Disclosure disclose that 'a haptic code' is extracted from the input signal and 'the extracted haptic code' may be directly applied. Examiner also notes that the output signal of the first device is the input signal of the second device. See figure 3 and paragraph 38 of Instant Application.

In a same way, Kaaresoja '471, discloses that 'a control signal' is extracted from input signal of Transceiver 104 via Controller 106) is configured to be directly applied to an actuator (see Fig. 1, Vibration Motor 100) of the second handheld communication device to cause the haptic effect.

As to claim 40, the modification teaches, the method of claim 32, further comprising:

receiving a second indication that a second one of the plurality of user interface members has been actuated, wherein the second one of the plurality of user-interface members is assigned with a second haptic code configured to convey a second expression or behavior, wherein the second haptic code is different from the first haptic code (Note, illustration of one phone device implies that there are

multitude of phones making connection that one phone and mere duplication is not an inventive concept);

generating a second output signal in response to the second indication, wherein the second output signal includes the second haptic code; and

sending the second output signal to the second handheld communication device, wherein second output signal is configured to cause a second haptic effect corresponding to the second haptic code.

As to claim 41, the modification teaches, the method of claim 32, further comprising:

receiving a signal from the second handheld communication device, wherein the signal includes a third haptic code configured to cause a third haptic effect (Note, illustration of one phone device implies that there are multitude of phones making connection that one phone and mere duplication is not an inventive concept); and

generating, at the first handheld communication device, the third haptic effect in response to the signal.

As to claim 42, the modification teaches, the method of claim 41, wherein the output signal and the signal are communicated during a chat session between the first

handheld communication device and the second handheld communication device (Computer Mediated Communication tools, see Fukuhara, Page 2).

***Response to Arguments***

Applicant's arguments filed 9/20/2010 have been fully considered but they are not deemed to be persuasive.

**Applicant argues, a caller-id feature is merely a feature that identifies at a receiving phone a calling party based on a calling party's phone number. In other words, any haptic effect in response to the phone number is identified at the receiving phone after a phone call is received (such as when the receiving phone rings or vibrates in response to the call). In contrast, the claimed output signal is generated at a first handheld communication device upon actuation of one or more of a plurality of user- interface members of the first handheld communication device, wherein the output signal includes the haptic code as claimed. The output signal is then sent to a second handheld communication device. In other words, the haptic code is included in the output signal from the first handheld communication device before being received by the second handheld communication device. This difference highlights**

Examiner disagrees with applicant. The Kaaresoja '471 discloses, in Figure 1, that the Transceiver 104 receives and transmits tactile sensation pattern. Perhaps, the phone numbers are attached or included in the sensation pattern; however, that possibility does not eliminate the fact that Transceiver 104 is sending and receiving tactile sensation pattern. The association one makes with phone number and tactile sensation received sufficient to encompass the scope of Applicant's invention.

**Applicant argues, In particular, claim 32 recites, among other things, "at least one of the plurality of user-interface members is assigned with a haptic code configured to convey an expression or behavior" and "sending the output signal to a second handheld communication device remote from the first handheld communication device." Claims 33 and 34 recite similar features. In the May 2010 Office Action, the Examiner alleges that Wanderlich at col. 7, lines 6-25, discloses this feature. However, Wanderlich describes communicating with a human vibrator device, not a second handheld communication device as claimed. For at least this reason, the references relied upon by the Examiner do not teach or suggest at least this feature of the claims.**

Examiner disagrees with applicant. In response to applicant's argument that above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). For instance, the Primary reference discloses a phone device that implies multiple users where flows of communications are at minimum bidirectional.

**Applicant argues, Applicants request clarification as to how merely mentioning a chat session in Fukuhara discloses, teaches, or suggests including a haptic code from one communication device to another communication device during a chat session.**

Examiner disagrees with applicant. Fukuhara makes a distinction between a 'wet information' and computer mediated communication. The one type of wet information involves a person to person gossip or chat sessions with physical presence. The Fukuhara proposes a haptic communication that could emulate such wet information.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyun Nam whose telephone number is (571) 270-1725 and fax number is (571) 270-2725. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Henry Tsai can be reached on (571) 272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Henry W.H. Tsai/

Supervisory Patent Examiner, Art Unit 2184